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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,845	12/26/2001	Jerry C. Trippe	G1693.0001/P001	4381

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DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
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EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 10/16/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/025,845

Applicant(s)

TRIPPE ET AL.

Examiner

Anthony J. Green

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 10-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 10-11, and 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 13 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group IV, claims 12-13 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the search and examination of the entire application can be made without serious burden as Group IV contains only claims 12-13 which represent 2 out of 17 submitted claims. This is not found persuasive because applicant has presented unsubstantiated arguments as no proof has been submitted showing that it is not a serious burden to examine all claims. Just because the elected group represents only a small portion of the claims is no basis for an argument, particularly since applicant is the one who elected the specific group. Therefore as seen by the different classification, every different use of the compound is classified in a different class and subclass from each other and thus a serious burden does exist for the examiner to examine all claims.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12-13 and 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claims 12 and 21 the phrase "ultrahigh molecular weight" is vague and indefinite as "ultrahigh" is a relative term. Therefore it is unclear as to type of polyisobutylene encompassed by the claims.

In claim 18 the phrase "the ultrahigh molecular weight polymer" lacks proper antecedent basis.

In claim 19 it is unclear as to what is meant by the term "BASF Oppanol B-246". This term is considered indefinite since the relationship between a trademark and the product it identifies is sometimes indefinite, uncertain or arbitrary. The formula or characteristics of the product may change from time to time and yet it may be sold under the same trademark. In the claims, every element or ingredient of the composition should be set forth in positive, exact, intelligible language so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. See MPEP 608.01(v). *Ex parte Kattwinkel* 12 USPQ 11.

Allowable Subject Matter

4. Claims 12-13 and 18-21 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Information Disclosure Statement

5. The references cited by application have been considered however they are not seen to teach and/or fairly suggest the instant invention.

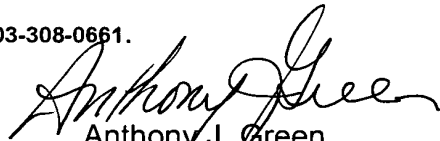
References Cited By The Examiner

6. The references are cited as showing the general state of the art and as such, they are not seen to teach and/or fairly suggest the instant invention. Nagy et al (US Patent No. 6,462,009) is the closest prior art as it teaches compositions comprising polyisobutylenes in combination with amino-functional polyorganosiloxanes (see tables 27 and 28) however the reference fails to teach the presence of a mineral oil also, the instant application's effective filing date predates that of the reference and therefore the reference cannot be used to reject the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 703-308-3819. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 703-308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
September 24, 2003